

REMARKS

Claims 1-16 and 18-20 remain in the application including independent claims 1 and 14. New claims 21-33 have been added including independent claim 24. Claim 17 has been cancelled.

The amendments to the specification and drawings are not related to any rejections or objections set forth in the subject official action. The revisions have been made solely to provide consistent terminology and numbering throughout the application. Further, Figures 4 and 5 have been revised to include numbering consistent with the description and to eliminate duplicate numbering.

Claims 5, 6, 11, 12, and 17 are indicated as allowable. Claim 17 has been incorporated into claim 14, thus claims 14-16 and 18-20 are now in condition for allowance.

Claims 14, 16, 18, and 19 stand rejected under 35 U.S.C. 102(b) as being anticipated by Nakayama or Kargilis. This rejection is moot based on the amendments set forth above.

Claims 1-4, 7-10, 15, and 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nakayama alone. First, the examiner has indicated that claims 5 and 6 are allowable. Claims 7 and 8 depend from claims 5 and 6, thus, claims 7 and 8 should also be indicated as allowable. Second, the rejections of claims 15 and 20 are moot in light of the amendments set forth above.

Thus, claims 1-4 and 10 stand rejected under 35 U.S.C. 103(a) based on Nakayama. The examiner argues, "Nakayama et al show everything except a throttle hose portion." The examiner does not provide any indication of what figures and what components in Nakayama correspond to applicant's claimed elements as set forth in claims 1-4 and 10. Applicant

respectfully requests that the examiner identify by number, which components in Nakayama correspond to the first shell, the second shell, and the air path that extends from the air filter to the engine cylinder head, which the examiner argues is completely formed within the first and second shells.

Claim 1 also requires a throttle hose portion that is supported on at least one of the first or second shells. The examiner admits that this is not shown but argues that it would be obvious to replace the throttle body of Nakayama with a hose and throttle body as disclosed in the subject application.

When it is necessary to select elements from different references in order to form the claimed invention, there must be some suggestion or motivation to make the selection. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. The extent to which such suggestion must be explicit in, or referred from, the references, is decided on the facts of each application in light of the prior art and its relationship to the claimed invention. It is impermissible to engage in a hindsight reconstruction of the claimed invention, using applicant's structure as a template and selecting elements from the references to fill the gaps. The references themselves must provide some teaching whereby applicant's combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

The examiner is clearly applying hindsight reconstruction of the claimed invention by using applicant's structure as a template and selecting elements from the references to fill the gaps. There is absolutely no teaching in Nakayama of using any type of throttle hose to form

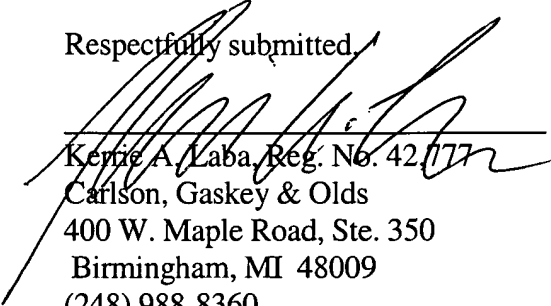
part of an air path between an air filter and an engine cylinder head. Nakayama teaches attaching a throttle 50 to a side of the air cleaner 10. There is no need for a throttle hose in this configuration, thus there would be no reason to modify Nakayama to include such a feature.

The only teaching of supporting a throttle hose portion on at least one of the first and second shells is found in the subject application. The examiner has pointed to no teaching of any particular benefit to using a throttle body and hose in place of the Nakayama throttle body. In addition, there is nothing in Nakayama that would have led one of ordinary skill in the art to believe that Nakayama's throttle body was in any way deficient for Nakayama's purposes or was in need of modification, especially as the Nakayama throttle body was specifically designed for attachment to the air cleaner housing on a side opposite from the engine. One of ordinary skill in the art would have found no reason, suggestion, or incentive for attempting to combine these references so as to arrive at the subject matter of claim 1 other than through the luxury of hindsight accorded one who first viewed applicant's disclosure. This is not the proper basis for a rejection under 35 U.S.C. 103(a) and applicant request that the rejection be withdrawn.

For the reasons set forth above, applicant believes that all claims are now in condition for allowance. An indication of such is requested. A check is enclosed to pay for additional claim fees. Applicant believes no additional fees are due, however, the Commissioner is authorized to

charge Deposit Account No. 50-1482 in the name of Carlson, Gaskey & Olds for any additional fees or credit the account for any overpayment.


Respectfully submitted,


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CERTIFICATE OF MAIL

I hereby certify that the enclosed Response is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 29 day of September, 2004.


Laura Combs